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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* KURIACOSE JOSEPH,
9 ANSLEY WAYNE JESSUP JR.,
10 VINCENT DUREAU,
11 and ALAIN DELPUCH
12

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14 Appeal 2011-007917
15 Application 09/903,457
16 Technology Center 3600
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20 Before HUBERT C. LORIN, ANTON W. FETTING, and
21 MEREDITH C. PETRAVICK, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23
DECISION ON APPEAL

STATEMENT OF THE CASE¹

Kuriacose Joseph, Ansley Wayne Jessup Jr., Vincent Dureau, and Alain Delpuch (Appellants) seek review under 35 U.S.C. § 134 (2002) of a non-final rejection of claims 165-167, 185, 218-220, 236, 252, and 256-261, the only claims pending in the application on appeal. This is a reissue application from application number 08/233,908, U.S. Pat. No. 5,819,034, issued October 6, 1998. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a client-server distributed computer system (Specification 1:5-6).

An understanding of the invention can be derived from a reading of exemplary claim 165, which is reproduced below [bracketed matter and some paragraphing added].

165. A method to facilitate placing an order for an item, the method comprising:

[1] receiving an order request at a client system;

[2] automatically determining an item identity for an item to which the order request pertains;

[3] automatically retrieving personal information previously stored in a permanent memory in the client system, the retrieved personal information pertaining to a user associated with the client system; and

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 17, 2010) and the Examiner's Answer ("Ans.," mailed January 12, 2011).

1 [4] causing an order to be placed, the order including the item
2 identity and the retrieved personal information.

3 The Examiner relies upon the following prior art:

Garneau	US 5,497,420	Mar. 5, 1996
Florin	US 5,621,456	Apr. 15, 1997

4 Claims 165-167, 185, 218-220, 236, 252, and 256-261 stand rejected
5 under 35 U.S.C. § 251 as having a defective reissue declaration because the
6 error which is relied upon to support the reissue application is not an error
7 upon which a reissue can be based.

8 Claims 165-167, 185, 218-220, 236, 252, and 256-261 stand rejected
9 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed
10 subject matter surrendered in the application for the patent upon which the
11 present reissue is based.

12 Claims 165-167, 185, 218-220, 236, 252, and 256-261 stand rejected
13 under 35 U.S.C. § 103(a) as unpatentable over Florin and Garneau.

14 ISSUES

15 The issues of propriety of the declared error and recapture turn primarily
16 on whether the Appellants described the error with any degree of
17 particularity and whether any of the claims are drawn to an invention similar
18 to those in any of the 9 original claims in the issued patent. The issue of
19 obviousness turns primarily on whether the term “personal information” is
20 broad enough to encompass the identification of a terminal personally used.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Parent Patent U.S. 5,819,034

01. The issued patent contains 9 claims.
02. All of those original claims are cancelled in the instant application.
03. All of those original claims are presented in divisional application [sic, divisional-reissue, see 7/10/2001 preliminary amendment] 09/903,458, whose prosecution is currently suspended pending allowability of one of the other reissue, divisional, or divisional-reissue applications.
04. All 9 claims in the issued patent covered an invention sending and receiving time division multiplexed packets. None of the claims in the instant application covers such an invention.

Facts Related to the Prior Art

Florin

05. Florin is directed to presenting an improved audio-visual user interface for selecting and displaying cable television or other audiovisual programs, as well as controlling various audio-visual devices and interactive services. Florin 2:37-40.

Garneau

06. Garneau is directed to pay per view or the equivalent service which does not require the downloading of a descrambling or subscriber terminal enabling code from a head end on a terminal by terminal basis, and can be used to allow service providers to provide services such as banking, merchandise ordering, personal information storage and retrieval, etc. to a population of subscribers. In addition, the system can facilitate the use of a single network by multiple cable TV operators without the danger that a subscriber of one can order programming or services from another. Garneau 1:48-58.

07. Garneau 's terminal address (I.D.) retrieves the program or service identification code corresponding to the selected program or service, and utilizing an encryption key, processes the program number and terminal ID through an algorithm using the encryption key to form an encrypted event request code, which is displayed on the television screen. The subscriber then initiates the action of placing an order for a pay-per-view event. Garneau 2:24-32.

ANALYSIS

Claims 165-167, 185, 218-220, 236, 252, and 256-261 rejected under 35 U.S.C. § 251 as having a defective reissue declaration because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based.

The Appellants' declarations state that :

1 the '034 patent also discloses a method and system that, stated
2 generally, uses a client system to facilitate the determining of
3 an item identity for an item to which an order request pertains,
4 automatically retrieving personal information previously stored
5 in a permanent memory in the client system, and causing an
6 order to be placed, where the order including the item identity
7 and the retrieved personal information. This invention is
8 distinct from the invention claimed in the original patent; and is
9 not in any way claimed in the issued claims of the '034 patent.

10
11 The Examiner found

12 [t]his statement of error is not sufficient because it does not
13 identify a single word, phrase, or expression in the
14 specification or in an original claim (s) 1-9, and how it
15 renders the original patent wholly or partly inoperative or
16 invalid. The statement filed is no better than saying in the
17 reissue declaration that this 'application is being filed to correct
18 errors in the patent which may be noted from the change made
19 by adding new claim [10]"; see MPEP 1414, II, C. Ans. 6.

20
21 Thus, the issue appears to be whether the reason provided by the
22 Appellants provided any specific detail. We find the phrase "facilitate the
23 determining of an item identity for an item to which an order request
24 pertains, automatically retrieving personal information previously stored in a
25 permanent memory in the client system, and causing an order to be placed,
26 where the order including the item identity and the retrieved personal
27 information" in the Appellants' declaration describing what the original
28 claims omitted has sufficient specificity.

29 The portion of the MPEP the Examiner cites requires that the public be
30 put on notice as to the particular nature of the correction, and the reason
31 provided by the Appellants certainly describe generally the nature of the
32 claims that are to be added. This statement is more than merely being the

equivalent of stating “that the original claims did not cover certain embodiments/language being presented by new claim 10” as the Examiner found. One does not have to look at the specific claims being added to appreciate the nature of the error being corrected. The most recent version of the MPEP now has the following sentence prior to the portion cited by the Examiner.

A statement of "failure to include a claim directed to" and then presenting a newly added claim, would not be considered a sufficient "error" statement because applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa.

MPEP 1414, II, C. Thus, this portion of the MPEP puts the phrasing regarding hypothetical new claim 10, *supra*, in context as merely requiring that the Applicants do more than just recite the added claim numbers and contents without regard to the existing claims. Clearly the Appellants’ declaration has pointed out what the original claims lacked and the newly claims have.

Claims 165-167, 185, 218-220, 236, 252, and 256-261 rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The Examiner found that none of the claims currently rejected are directed to the same invention as any of the original claims from the issued patent, and that ordinarily, under such a circumstance, no recapture could be found. Ans. 17-20. The Examiner further made a finding that if all the original claims from the issued patent are canceled, then recapture may then be found. *Id.*

1 The Appellants dispute this. We must agree with the Appellants. We
2 are at a loss to see how the Examiner arrived at this finding as to an
3 exception to the case where claiming entirely new inventions does not
4 involve recapture.

5 First, the original claims remain intact in another divisional. FF Error!
6 Reference source not found.. There is no requirement that the original
7 claims remain with the first reissue application. Second, the Examiner
8 appears to base the finding on a view that the subject matter that materially
9 narrows the reissue claims should be the overlooked aspect of the original
10 invention *claimed* in the patent. This view holds up for recapture in claims
11 directed to the same invention as in the original claims, but this is
12 nonsensical for wholly different inventions, if only because with claims to
13 such different inventions, the original invention is not in the claim.
14 Therefore it is logically inconsistent to require the overlooked aspects be
15 those of the originally claimed invention. We find no authority in the
16 statutes, case law, or even the MPEP for the Examiner's finding. Instead,
17 the Court of Appeals for the Federal Circuit recently held that no recapture
18 exists in such circumstance.

19 The Board's reliance on this portion of the MPEP is misplaced.
20 This portion of the MPEP deals with claims in which there is no
21 need to apply the recapture rule in the first place. The recapture
22 rule is triggered only where the reissue claims are broader than
23 the patented claims because the surrendered subject matter has
24 been re-claimed in whole or substantial part ... In contrast, this
25 portion of the MPEP addresses reissue claims directed at
26 "additional inventions/embodiments /species not originally
27 claimed." Because the subject matter of these claims was "not
28 originally claimed," it is wholly unrelated to the subject matter

subject matter surrendered in the application for the patent upon which the present reissue is based is improper.

The rejection of claims 165-167, 185, 218-220, 236, 252, and 256-261 under 35 U.S.C. § 103(a) as unpatentable over Florin and Garneau is proper.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 165-167, 185, 218-220, 236, 252, and 256-261 under 35 U.S.C. § 251 as having a defective reissue declaration because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based is not sustained.
- The rejection of claims 165-167, 185, 218-220, 236, 252, and 256-261 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is not sustained.
- The rejection of claims 165-167, 185, 218-220, 236, 252, and 256-261 under 35 U.S.C. § 103(a) as unpatentable over Florin and Garneau is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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AFFIRMED

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